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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/770,874	01/26/2001	Samuel Dinkin	YOR920000312 (1963-5014)	6668
7590	07/06/2005		EXAMINER	
STEPHEN C. KAUFMAN INTERNATIONAL BUSINESS MACHINES CORPORATION P. O. BOX 218 ROUTE 134/1101 KITCHAWAN ROAD YORKTOWN HEIGHTS,, NY 10598			SUBRAMANIAN, NARAYANSWAMY	
		ART UNIT	PAPER NUMBER	
			3624	
DATE MAILED: 07/06/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/770,874	DINKIN ET AL.
	Examiner Narayanswamy Subramanian	Art Unit 3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 11 April 2002.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-60 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-60 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on 01 February 2002 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

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1. The amendments to the title of the invention made in the Applicants' communication of April 11, 2002 have been entered. Original claims 1-60 have been examined. The objections and rejections are stated below.

Specification

2. The specification is objected to because the background of the invention begins abruptly on page 2. It appears like the first page of the specification is missing. Clarification is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

4. Claims 2-4, 10-15, 17-19, 25-30, 32-34, 40-45, 47-49 and 55-60 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "similar needs" in claims 2, 17, 32 and 47 is a relative term, which renders the claim indefinite. The term "similar needs" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claims 3, 4, 18, 19, 33, 34, 48 and 49 recite the limitation "said entities". There is no antecedent basis for this limitation. The independent claims recite "at least one entity".

Claims 10, 25, 40 and 55 recite the limitation "the offered prices". There is no antecedent basis for this limitation.

Claims 11, 26, 41 and 56 recite the limitation "the perceived quality of the goods or services being offered". There is no antecedent basis for this limitation.

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Claims 12, 27, 42 and 57 recite the limitation "the type of goods or services being offered". There is no antecedent basis for this limitation.

Claims 13, 28, 43 and 58 recite the limitation "the perceived reliability". There is no antecedent basis for this limitation. Also the term "perceived reliability" in these claims is a relative term, which renders the claim indefinite. The term "perceived reliability" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claims 14, 29, 44 and 59 recite the limitation "the perceived optimum solution". There is no antecedent basis for this limitation. Also the term "perceived optimum solution" in these claims is a relative term, which renders the claim indefinite. The term "perceived optimum solution" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claims 15, 30, 45 and 60 recite the limitation "translating terms of art contained within said request". There is no antecedent basis for this limitation. Also it is not clear as to what the applicant means by the term "translating terms of art contained within a request". Appropriate correction/clarification is required.

Claims 16-45 cite the limitation "system". It is not clear if by the term "system" the applicants mean "a method", "a process" or "an apparatus". Clarification is required.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. § 101 reads as follows:

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"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title".

6. Claims 1-15 and 46-60 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.

35 USC §101 requires that in order to be patentable the invention must be a "new and useful process, machine, manufacture, *or* composition of matter, *or* any new and useful improvement thereof" (emphasis added).

Claims 1-15 and 46-60 are rejected under 35 U.S.C. § 101 because; the claimed invention is directed to a non-statutory subject matter. Specifically the method claims as presented do not claim a technological basis in the pre-amble and the body of the claim. Without a claimed basis, the claim may be interpreted in an alternative as involving no more than a manipulation of an abstract idea and therefore non-statutory under 35 U.S.C. § 101. In contrast, a method claim that includes in the body of the claim structural / functional interrelationship which can only be computer implemented is considered to have a technological basis [See Ex parte Bowman, 61 USPQ2d 1669, 1671 (Bd. Pat. App. & Inter. 2001) - used only for content and reasoning since not precedential].

Similarly the computer program claims as presented do not claim a technological basis in the preamble and the body of the claim. Without a claimed basis, the claim may be interpreted in an alternative as involving no more than a manipulation of an abstract idea and therefore non-statutory under 35 U.S.C. § 101. In contrast, a computer program claim that includes in the body of the claim structural / functional interrelationship which can only be computer implemented is

considered to have a technological basis [See *Ex parte Bowman*, 61 USPQ2d 1669, 1671 (Bd. Pat. App. & Inter. 2001) - used only for content and reasoning since not precedential].

In order to overcome the 101 rejection above, the following preamble is suggested for the method claims: "A computer implemented method for fulfilling at least" or something similar. Also, in the body of the claim include structural / functional interrelationship which can only be computer implemented.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Woolston (US Patent 6,085,176).

With reference to claims 1, 16, 31 and 46, Woolston discloses a method, system and a computer program for fulfilling at least one need comprising: receiving at least one request; identifying a plurality of markets that are capable of fulfilling said request; requesting at least one offer to fulfill said request from at least one entity within said identified markets; and communicating at least a portion of said offers to a party making the request (See Woolston claims 1 and 7). A system and a computer program for performing the above steps are inherent in the disclosure of Woolston.

With reference to claims 2-15, 17-30, 32-45 and 47-60, Woolston discloses markets capable of fulfilling similar needs (See Woolston Column 1 lines 12-65, similar needs are interpreted to include goods that are similar); facilitating a transaction between said party making the request and at least one of said entities within said identified markets (See Woolston Column 3 lines 33-50); withholding the identity of said party making the request for a period of time from said entities within said identified markets (See Woolston Column 7 lines 41-49); offers are made through an auction (See Woolston Column 5 line 52 – Column 6 line 14, auctions are interpreted to include open and sealed auctions); offers are made through a series of negotiations (old and well known way of conducting a transaction); offers are made through a posting of a price (See Woolston Column 2 lines 3-6 and Column 6 lines 26-49); offers are offers for exchange of goods or services(See Woolston Column 5 line 52 – Column 6 line 14 and claim 28); communication of at least a portion of said offers includes the offered prices (See Woolston Column 6 lines 26-49); communication of at least a portion of said offers includes the perceived quality of the goods or services being offered (See Woolston Column 4 lines 8-12 and 55-64); communication of at least a portion of said offers includes the type of goods or services being offered (See Woolston Column 1 lines 12-65); communication of at least a portion of said offers includes the perceived reliability of said entities within said identified markets (See Woolston Column 4 lines 8-12 and 55-64); communication of at least a portion of said offers includes the perceived optimum solution to the fulfillment of said request (See Woolston Column 5 lines 10-20); identification is accomplished in part by translating terms of art contained within said request (See Woolston Claim 16).

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Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

(a) Waelbroeck et al (US Pub. No. 2002/0010672 A1) (January 24, 2002) Method for Directing and Executing Certified Trading Interests

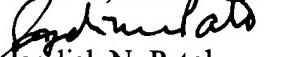
(b) Shapiro (US Pub. No. 2002/0091606 A1) (July 11, 2002) Predictive Automated Routing System (PARS) for Securities Trading

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Narayanswamy Subramanian whose telephone number is (571) 272-6751. The examiner can normally be reached Monday-Thursday from 8:30 AM to 7:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached at (571) 272-6747. The fax number for Formal or Official faxes and Draft to the Patent Office is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

N. Subramanian

June 24, 2005



Jagdish N. Patel

Primary Examiner